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Jan Chipchase

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EXAMINER

SYED, NABIL H

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,871	Applicant(s) CHIPCHASE ET AL.	
	Examiner /NABIL H. SYED/	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42,44-51,53-56,59 and 61-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42,44-51,53-56,59 and 61-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a final office action in response to the Amendment filed 4/06/09. Amendments received on 4/06/09 have been entered. Claims 31, 43, 58 were previously cancelled. As per applicant claims 29, 32-41, 52, 57, 58 and 60 are cancelled. Claims 64-81 are newly added claims. Accordingly claims 42, 44-51, 53-56, 59 and 61-81 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 62 and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As of claim 62 and 63, the limitation "a program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine" is not disclosed in the specification as originally filed. It is considered that the computer readable medium constitutes new matter. The Examiner referred to the pages the

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applicant pointed out, but none of those pages and other part of the specification discloses any teachings regarding the limitation of claims 62 and 63.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 42, 44-51 and 55, 62-66, 69-71 and 73-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (WO 01/50224) in view of Wischerop et al. (5,955,951) in view of Dosch (US Pub 2002/0069365).

As of claims 42, 55 and 62, Lin discloses an apparatus (via a RFID reader 120 and a network-enabled device 130; see fig. 1), comprising:
a radio frequency tag reader configured, , to read a code from the radio frequency tag (see page 8, lines 5-17);
a radio interface for transmitting and receiving data in a network (via the computer 130 transmitting the ID code of the tag and the reader to the network 140; see fig. 1; also see page 10, lines 19-22; Note: Lin discloses that computer 130 can be a portable lap

top, a portable electronic organizer a digital mobile telephone so it has to have a radio interface to connect with the network 140); and

Lin further discloses that the application software 132 can include a look up table that map the ID codes of the tags to specific applications, servers, web site URLs (see page 11, lines 29-32). Lin further disclose that if the reader determines that the RF tag is a type 3 tag based on the tag's identification, hence determining that the read code corresponds with a stored code, and then the application software will begin a local application program on the user computer, hence performing an operation associated with the corresponding stored code (see page 13, lines 25-32). Further with respect to the lookup table, Lin discloses that the server computer 150 extracts the RF tag's unique code from the UTC and matches it against the codes in the look-up database tables. From that description it can be seen that one skill in the art would know that the computer 130 can also perform the function of matching the code in the look-table database in the computer 130 (page 11, lines 29-32). Even though the Examiner believes that based on this description it can be seen that the terminal device 130 does store the unique code of the tags and after reading the tags code first it is compared with the codes stored in the look up table of the application software and when the code is not present the terminal device will transmits the unique code of the tag to the server, hence transmitting a message.

However Lin fails to explicitly disclose that the apparatus comprising a docking port and the RFID reader is configured, in response to the docking port receiving a device to read information form the tag.

Wischerop discloses a apparatus comprising a RFID reader (via a detaching unit 26, including a control circuit 92, wherein control circuit interrogates the tag 28; see col. 7, lines 53-65), detaching unit further comprising a nesting area 84 (docking port), the control circuit 92 interrogating the tag 28 only when the tag is in the nesting area 84 (see col. 7, lines 19-31; also see col. 7, lines 51-64; also see fig. 5).

From the teaching of Wischerop it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Lin to include a docking port on the apparatus as taught by Wischerop in order to eliminate any problem of interference from other tags that may be present at the vicinity of the reader (see col. 7, lines 62-65).

Further, the computer 130 and server 150 can be referred to as an apparatus claimed in claim 1. Line discloses that server computer 150 extracts the RF tag's unique code from the UTC and matches it against the codes in the look-up database tables (see page 6, lines 4-6). Lin further discloses that server matches the unique code in the data base and if the code is not authenticated (meaning code does not correspond with a stored code) an error message is displayed on the user computer 130 for the user (see page 12, lines 2-15).

In order to further support the Examiner's point of view Dosch discloses that an apparatus (via internet terminal 11; see fig. 1) stores the code of a radio frequency tag (via identification module 15; see fig. 1; also see paragraph [0024]) and authenticate the identification module 15 which enables the terminal device 11 to connect to the internet (paragraph [0030] and [0027]), hence performing an operation.

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From the teaching of Dosch it would have been obvious to one having ordinary skill in the art to modify the combination of Lin and Wischerop to include the step of storing the tags code in the terminal device as taught by Dosch so the risk of the theft of the terminal device can be reduced because the identification module is required to enable the terminal device (see paragraph [0013]).

As of claims 44, 45, 73 and 74, Lin discloses that if a “free tag” is used, a user can obtain free clips of audio tracks, movie trailer to play them on their computer/network enable device 130; see page 21, lines 1-15) and if a user uses a “special tag” they can listen to the radio content on a server computer via the computer 130 (see page 21, lines 31-33), hence different tag transmits different messages on the network and computer 130 performs different operation based the instructions received from the server..

As of claims 46 and 75, Wischerop discloses that the detaching unit 26 comprises a switch 86 in the nesting area 84 (docking port) to provide an indication that a tag 28 has been positioned in the nesting area 84 (see col. 7, lines 24-29).

As of claims 47 and 76, Wischerop discloses that the control circuit interrogates the tag only when a tag is in the nesting area 84 (see col. 7, lines 60-64).

As of claims 48 and 77, Lin discloses that the operation relates to sending an email (see page 9, lines 21-26). Further Dosch discloses that the user can use the RF tags to access the internet (see paragraph [0012]), and it is well known in the art that the user can use the internet service to send and received emails.

As of claims 49, 50, 78 and 79, Lin discloses that RF tag can be used as "business cards" to client. When placed in the proximity of a reader, the business person's email address will be displayed to the client and the user can type a message (amending the email) and send the email by pressing "send", hence requesting the user approval before sending the email (see page 25, lines 6-12)

As of claims 51 and 80, Lin discloses that each RF tag's unique code is linked to a web site URL, hence specifying the IP address or the domain name where the resource is located on the internet, and the user uses the computer 130 to open a browser (see page 5, lines 13-16).

As of claims 63, 65, 66, 70, 71 Lin discloses that application software 132 reads the RF tag unique code off of the tag, then checks if the local application program needs to be start, and if not, a message is transmitted to the server 150 including the tag's unique code (see page 13, lines 21-32).

As of claim 64 and 69, Lin discloses that the computer 130 reads the unique code from the tag and initiates a local application, for example launching a browser program (see page 6, lines 13-25), hence comprising a macro which is used by the computer 130 to perform the function of launching the browser. Lin further discloses that each code of the RF tag is mapped with a specific application or web site URL that is accessed via the computer network 140.

As of claim 81, Lin discloses all the limitations of claimed invention as mentioned in claim 42 above, Wischerop further discloses a device (via tag 28; see fig. 8), comprising: a casing configured to be received by a docking port of an apparatus (via

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enclosure 50; see fig. 5 and 3); a memory configured to store information (via RFID chip 64 storing multi-bit identification data; see col. 5, lines 56-60); and a radio frequency tag configured, in response to the reception of the casing by the docking port, to transmit the stored information to the apparatus, in order to enable the apparatus to transmit a message (via RFID chip 64 emitting an identification signal corresponding to the stored data in response to a radio frequency interrogation signal; see col. 5, lines 55-64; also see col. 7, lines 53-65; also see fig. 5).

6. Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (WO 01/50224) in view of Wischerop et al. (5,955,951) in view of Dosch (US Pub 2002/0069365) in view of Gallagher, et al. (6,963,270).

As of claims 53 and 54, Lin discloses that RFID reader reads plurality of tags and performs different functions based on the tag's unique code. Wischerope further discloses that the nesting area (docking port) interrogate the tag when the tag is placed in the nesting area. (Note: In the previous office action the Examiner took official notice stating that having multiple tags in the reader fields would have been obvious to one having ordinary skill in the art at the time the invention was made since it is well know in the art that RFID reader can have multiple tags in the reading area simultaneously).

In order to support the Examiner's notice Gallagher discloses a RFID system wherein a reader interrogates multiple tags located within an interrogation zone of the reader (see col. 2, lines 22-26).

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7. Claims 56, 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin, in view of Wischerop, in view of Dosch and further in view of Walter (6,275,141).

As of claim 56 and 61, Lin discloses an apparatus, comprising:
a memory configured to store first information (Lin discloses that the data of interest (first information) of a user is stored in a system server under a unique RF code; see page 23, lines 24-28);
a radio frequency tag reader configured to read second information from a radio frequency tag of a device (via RFID reader reading the unique code of the RFID tag (second information); see page 23, lines 27-29); and
a controller configured, in response to the reading of the second information from the radio frequency tag, to activate a secrecy mode by concealing the first information, such that the first information is inaccessible by an unauthorized user (Note: Lin discloses that the data of interest is stored in the system server under a unique RF code, hence first the RF tag's code is used to conceal the data of interest of the user. So every time when users wishes to acquire the data of interest he/she uses his/her tag to acquire the data, and after every use data is concealed since the tag will be required, the next time user wishes to acquire the data of interest; see page 23, lines 24 through page 24, lines 5).

However Lin does not explicitly disclose the step of concealing the first information when the first information is displayed on the display.

Walter discloses a single key security system wherein different functions such as using a cellular phone of the vehicle (see fig. 1) are available to the user. But when the processor 116 receives a signal from the remote control 102 it enables a valet mode (secrecy mode) wherein the use of the cellular phone and hence the information displayed on the cellular phone is disable (see col. 7, lines 35-45).

From the teaching of Walter it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Line to include the function of concealing some information as taught by Walter in order to provide the user with the option to give limited and restricted access to user's communication device.

As of claim 59, Even though not explicitly said but from the description of Lin it can be seen that when a person is given an RFID tag he/she is authorized to access the data of interest (first information) on the server computer via the network-enabled device, and after the user has viewed the information using the RF tag code (second information) the data of interest is concealed, unless the RF tag is presented again, hence the server system activate the secrecy mode by concealing the data for interest (first information) such that the data is inaccessible by an unauthorized user (Note: unauthorized user can be viewed as any user who does not posses an authorized RF tag). Further as discloses above the network-enabled device comprises a computer, hence comprising a display to view the data of interest (see page 23, lines 24-32; also see page 24, lines 15-20). Further when user is viewing the data of interest, of course

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they have the option to show the information to any individual they desire, whether that person possesses a valid RFID tag or not.

Lin further discloses that when the processor receives a signal from the remote control 102 it deactivates the valet mode so the user have full access to the vehicle, and devices in the vehicle (see col. 7, lines 35-45).

8. Claims 67, 68 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (WO 01/50224) in view of Wischerop et al. (5,955,951) in view of Dosch (US Pub 2002/0069365) and further in view of Katagishi et al. (US Pub 2003/0120745).

As of claim 67 and 72, the combination of Lin, Wischerop and Dosch discloses all the limitations of the claimed invention, however the combination fails to explicitly disclose that at least a part of the read code is used to select a remote server.

Karagishi discloses an information receiving system wherein a reader (via cellular phone 20; see fig. 1) reads a code from a RFID tag (via cellular phone 20 reading a server access address and product ID from the RFID tag 10; see fig. 1; also see paragraph [0057]), wherein the code (the part containing the server access address) is used to select a destination (server 30) (see fig. 1; also see paragraph [0055]-[0059]).

From the teaching of Karagishi it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Wischerop to include the step of using the code to select a destination as taught by Karagishi in order to improve the functionality of the PDA's or cellular as RFID reader so the reader automatically accesses the server based on the server access address.

As of claim 67, Katagishi discloses that the apparatus is a portable communication apparatus (via a cellular phone; see fig. 1).

Response to Arguments

9. Applicant's arguments filed 4/06/09 have been fully considered but they are not persuasive.

As of claim 42 and 55, applicant argues, "Neither Lin nor Wischerop nor Dosch discloses the feature of the controller configured to determine whether the read code corresponds with a stored code of the claimed invention." The Examiner respectfully disagrees.

First of all the Examiner would like to point out that claims 42 and 55 are rejected using the combination of Lin, Wischerop and Dosch. In the arguments the applicant seems to attach the references individually, whereas applicant cannot show non-obviousness by attaching references individually where, as here the rejections are based on combination of references. In re Keller, 208 USPQ 871 (CCPA 1981).

Lin discloses that the application software 132 can include a look up table that map the ID codes of the tags to specific applications, servers, web site URLs (see page 11, lines 29-32). Lin further disclose that if the reader determines that the RF tag is a type 3 tag based on the tag's identification, hence determining that the read code corresponds with a stored code, and then the application software will begin a local application program on the user computer, hence performing an operation associated with the corresponding stored code (see page 13, lines 25-32). Further with respect to the lookup table, Lin discloses that the server computer 150 extracts the RF tag's

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unique code from the UTC and matches it against the codes in the look-up database tables. From that description it can be seen that one skill in the art would know that the computer 130 can also perform the function of matching the code in the look-table database in the computer 130 (page 11, lines 29-32).

Further, the computer 130 and server 150 can be referred to as an apparatus claimed in claim 42. Line discloses that server computer 150 extracts the RF tag's unique code from the UTC and matches it against the codes in the look-up database tables (see page 6, lines 4-6). Lin further discloses that server matches the unique code in the data base and if the code is not authenticated (meaning code does not correspond with a stored code) an error message is displayed on the user computer 130 for the user (see page 12, lines 2-15).

Further Dosch discloses that an apparatus (via internet terminal 11; see fig. 1) stores the code of a radio frequency tag (via identification module 15; see fig. 1; also see paragraph [0024]) and authenticate the identification module 15 which enables the terminal device 11 to connect to the internet (paragraph [0030] and [0027]), hence performing an operation.

So from the description of Lin and Dosch it can be seen, that the specific codes of the tags can be stored remotely (via storing codes in the server 150 as disclosed in Lin) or the codes can be stored locally in the reader device (via storing the code in the internet terminal 11 as disclosed in Dosch). So in the reference of Lin when the tags are used to perform function on the computer 130, the codes of the tags can be stored in

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the computer 130 (as disclosed in Dosch) to authenticate the tag before performing any function on the computer 130.

From the teaching of Dosch it would have been obvious to one having ordinary skill in the art to modify the combination of Lin and Wischerop to include the step of storing the tags code in the terminal device as taught by Dosch so the risk of the theft of the terminal device can be reduced because the identification module is required to enable the terminal device and further making sure that an authorized tag is used to access the terminal device (see paragraph [0013]).

Both of the references of Lin and Dosch uses the RFID tags or transponder to perform different functions on an electronic device so it would have been obvious to one having ordinary skill in the art to combine the references of Lin and Dosch.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /NABIL H. SYED/ whose telephone number is (571)270-3028. The examiner can normally be reached on M-F 7:30-5:00 alt Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman can be reached on (571)272-3059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NABIL H SYED/
Examiner
Art Unit 2612

N.S

/Brian A Zimmerman/
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